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EXAMINER

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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* IEYASU KOBAYASHI, MITSUO TOJO,
11 TSUYONARI NOHIRA, SHINJI MURO,
12 and HIROFUMI MUROOKA
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15 Appeal 2009-0473
16 Application 09/914,033
17 Technology Center 3600
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20 Oral Hearing Held: April 21, 2009
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23 Before WILLIAM F. PATE, III, STEVEN D. A. McCARTHY,
24 STEFAN STAICOVICI, *Administrative Patent Judges*.
25

26 APPEARANCES:

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37 PROCEEDINGS

38 MS. BOBO-ALLEN: Calendar No. 31, Appeal No. 2009-0473,
39 Mr. Dutton.

1 JUDGE PATE: Okay, thank you, Pat.

2 Good afternoon, Mr. Dutton.

3 MR. DUTTON: Good afternoon.

4 JUDGE PATE: I'll let you start by introducing your guest.

5 MR. DUTTON: Okay, thank you very much. Yeah, my guests are
6 two colleagues here, Mr. Patel and Mr. Eiezomi (phonetic sp.), and they're
7 going to be seeing what, what we do in here today.

8 JUDGE PATE: Okay. And we had a chance to look at this
9 technology beforehand, and so we're up to speed on the invention. We'd like
10 to hear your arguments about patentability.

11 MR. DUTTON: Oh, okay, thank you very much, thank you very
12 much. That will cut down quite a bit of the time. May it please the court,
13 my name is Brian Dutton. I'm the counsel for -- Unlimited, the Appellant
14 before this court today. The following issues before this court today which I
15 will argue is the first -- there are two issues, first, dealing with the group
16 Claims 1 through 15 and the second issue dealing with the group for Claims
17 16 through 24.

18 In summary for both of these, and maybe I can speed up the process,
19 what we're looking at here is ways of, of determining or having a product
20 that is wrinkle-free. It's just a, just a roll that's wrinkle-free. And the, the --
21 for the first group of claims, which would be 1 through 15, the, the
22 Examiner's Answer appears to highlight this feature of the claim, and I'm
23 going to quote it from Claim 1, the difference are being the maximum
24 diameter value and the minimum diameter value is not more than $2W \times 10$
25 to the minus 3rd, and not more than $L \times 10$ to the minus 7, wherein W is the

1 width of the film role and L is the length of the roll of film. Now, the Sasaki
2 reference has no -- whatsoever that we can find regarding the dimensions
3 related to the diameter of the roll.

4 JUDGE McCARTHY: Counsel, are you saying that one of skill in the
5 art prior to your invention would have had no interest in making the role as
6 cylindrical as possible?

7 MR. DUTTON: As cylindrical as possible?

8 JUDGE McCARTHY: Yes.

9 MR. DUTTON: What I am saying is that, you know, the Sasaki
10 reference, he had talked about wrinkles and wrinkles-free, but what we're
11 talking about is, is, you know, determining this diameter of the roll itself.
12 And I guess, you know, referring to it as being as cylindrical as possible, I
13 guess we see no teaching within Sasaki of, of that way that we have our
14 particular invention.

15 JUDGE McCARTHY: But isn't, isn't the desire to make the minimum
16 and the maximum diameter as close as possible something that would be
17 within the common sense or common knowledge of one skilled in the art?

18 MR. DUTTON: Well, Sasaki doesn't teach that, that there would be
19 anything -- any sort of teaching for that particular purpose.

20 JUDGE McCARTHY: I realize that Sasaki has no express teaching to
21 that effect, but KSR, as I read it, does permit us to look at, at the common
22 sense that one who is skilled in the art would have. And it strikes me that
23 making the minimum and maximum diameter as close as possible would be
24 a matter of common sense.

1 MR. DUTTON: Well, well, it, it may possibly not be. You know, I
2 guess under KSR as well from a manufacturing standpoint. It could quite
3 possibly be more expensive for a manufacturer to hone these things in with
4 such fine tolerances so that it might not necessarily be common sense based
5 on the way that a piece of film is rolled. Why you would even want to have
6 that sort of fine tolerance when there may be additional costs involved in the
7 equipment and the, and the other manufacturing techniques to get to that
8 level of quality. So -- and the thing is that whether or not this sort of fine
9 precision that we are claiming is actually desired in the prior art, there is no
10 teaching that we can find that the Examiner has presented that would have --
11 that we would have been able to reach that conclusion.

12 So I guess our particular point is, you know, basically that this Sasaki
13 reference does not teach -- there's no teaching about the diameters. And, and
14 to illustrate, Sasaki goes into great detail about the surface roughness and the
15 hardness. And it would seem to me that, that if it were true under KSR that
16 the skilled artisan would have recognized that, then it appears that Sasaki
17 would have had that sort of discussion as well. Sasaki is silent, silent
18 regarding any discussion whatsoever dealing with the diameter of the roll
19 itself. So, it appears to me that the skilled artisan would have looked at
20 Sasaki and determined that that particular feature of the roll itself would not
21 be relevant in reaching its particular qualities that Sasaki is trying to -- has,
22 has set forth in his patent.

23 But we're doing something different, we have a different product.
24 And our product which is stated in Claim 15 has a certain physical
25 dimension which just -- which we believe is not captured by Sasaki. Now,

1 going to Claim 16, the, the Examiner appears to have highlighted in his
2 Examiner's Answer the feature wherein -- which is, of course, the last line of
3 our Claim 16, wherein the first maximum perpendicular line is not more than
4 500 micrometers and the second maximum perpendicular line length is not
5 more than 300 micrometers. And this is a similar problem that we've seen
6 with the Sasaki reference. And keep in mind Claims 1 and 16, the rejections
7 were not under 103, but were under 102. Now, I do understand that, of
8 course, there was a rejection as well under 103 which would have been
9 through some of the dependent claims. So, I, I appreciate that, but just
10 wanted to lay that, that out as well as far as the, the KSR teachings and
11 things of that nature.

12 But going back to my arguments regarding the, the Claim 16 and the
13 Sasaki reference, again, this Claim 16 deals with diameters and
14 determinations of diameters. And -- but the thing about the Sasaki reference
15 is that there is no teaching of diameters and any variations along the length
16 of this roll, on what those diameters are, and how those diameters should be.
17 It's quite possible that the skilled artisan would have had a diameter where,
18 you know, it would have, you know, been maybe conical in nature.
19 However, that sort of thing may not necessarily have been in our claim, but
20 it may be something that could have read upon the Sasaki reference. So,
21 there are instances where within the final office action and the examiner's
22 answer where the examiner says that these things are necessarily present.
23 And our position is that there's no teaching within this reference that, that
24 these variations and these features of dimension that we have claimed would
25 be the necessary outcome of this Sasaki reference. And basically, that, that's

1 all that we wanted to say about this at this presentation. The rest of it we, we
2 did describe in our, our Reply Brief as well and our Appeal Briefs. So, I
3 don't know if there are any additional questions?

4 JUDGE STAICOVICI: Just one question. Sasaki also teaches that
5 the purpose of the invention is to be -- have a film that's free from wrinkles.

6 MR. DUTTON: Correct.

7 JUDGE STAICOVICI: Why isn't that terminology -- talking about
8 diameters? If you don't have any wrinkles, I assume the diameter is
9 uniform.

10 MR. DUTTON: Ah. Well, to give you an idea, it's a film roll, right?
11 One end smaller than the other, okay. Perhaps no wrinkles, but a non-
12 uniform diameter. So, it's not -- with that, Sasaki does not necessarily
13 preclude that sort of thing occurring because there's no discussion in the
14 reference about diameters and how those diameters are treated. So, so the
15 arguments of the, the uniformity being necessarily present, there's no
16 teaching within this reference of that, of that actually occurring or being,
17 being the natural byproduct of this reference.

18 JUDGE PATE: Any more questions? I have no more questions for
19 you either. We're going to take this case under advisement.

20 MR. DUTTON: Thank you very much, thank you for your time.

21 JUDGE PATE: Do you have a business card for the court reporter?

22 MR. DUTTON: No, I don't, I'm sorry.

23 JUDGE PATE: If you don't, I'll just spell your name.

24 MR. DUTTON: Okay, my first name is Brian,

25 B R I A N, and the last name is Dutton, D U T T O N.

1 JUDGE PATE: Thank you very much.

2 COURT REPORTER: That reference was spelled

3 S A S A K I.

4 MR. DUTTON: Thank you very much.

5 (Whereupon, the hearing concluded on April 21, 2009.)

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